

No. 2918. 5

United States
Circuit Court of Appeals,
FOR THE NINTH CIRCUIT.

Union Tool Company,

Appellant,

vs.

Elihu C. Wilson,

Appellee.

PETITION FOR REHEARING.

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CLERK

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<i>vs.</i>	
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PETITION FOR REHEARING.

The defendant-appellant feeling itself aggrieved by the decision herein rendered by this Honorable Court on February 11, 1918, comes now and respectfully petitions the court for a rehearing of this cause upon the grounds hereinafter stated.

I.

(a) The District Court fell into the manifest error of failing to give claims 9 and 19 their plain meaning and decided this case without regard to the subject matter to which said claims are directed and without regard to the meaning asserted thereto by appellee

when presenting the same to the patent office for allowance; and

(b) This court has failed to correct this obvious error or to point out the true interpretation or meaning of either of these claims or adjudge the scope thereof, or to construe either of said claims; and

(c) Has failed to apply in its decision herein the rule of construction announced and applied in its decision contemporaneously rendered in the companion case No. 2996.

II.

This court has fallen into a misapprehension as to the issues raised by the pleadings in the two cases A-4 and B-62.

III.

This court has apparently fallen into the error of considering this appellant's appeal *not on appellant's assignments of error*, but as though the case were before the court on an appeal by appellee and has decided the case solely from such viewpoint and not considered that only the matters raised by appellant's assignments of error are before the court.

1. Prior to the Double patents there were underreamers, but they were not adapted to the deep drilling required in California. Double invented and patented successful underreamers under three separate patents. Later Wilson produced an underreamer and obtained a patent.

2. *Taken separately*, the mechanical elements in the Double underreamers were not new, but the *combination* of these elements and the resultant “modes of operation” were new.

3. *Taken separately*, the mechanical features of the Wilson underreamers were not new, but were designed to be improvements upon existing reamers; but the *combinations* of certain of the Wilson features were somewhat different and the resultant mode of operation was in part the same or the mechanical equivalent of Double’s reamer, and in part was an improvement upon the Double mode of operation,—while using a large part of the Double contribution to the “prior art” as a basis for the Wilson improvement.

4. The District Court apparently saw and recognized these facts, *abstractly*, but failed to hold in mind and apply what was truly covered by the Wilson patent under claims 9 and 19.

5. The District Court enlarged claims 9 and 19 by “judicial construction” beyond their true import and read into each of them features which are in no wise found in the claims themselves and which are not at all original with Wilson and which formed no possible part of any “combination” described by either of these claims. *And read out* of each of these claims the distinct improvement which Wilson asserted he had produced and by which he differentiated his invention from the Double reamers in securing the grant of his patent.

6. It cannot be shown that Wilson's "combination" of features or his distinctive "mode of operation" has been infringed by any Double device as to claims 9 and 19, if the normal, plain and unambiguous meaning of those claims be followed.

7. Neither the District Court nor this Honorable Court has undertaken in case No. 2918 to point out the exact things about the Wilson device which are owned by Wilson as the new and novel features under claims 9 and 19, and of which he is by those claims given a monopoly.

Insofar as the District Court has undertaken to point out any such features not plainly described on the face of claims 9 and 19, it has created for Wilson by super-adding to those claims entirely new matter not therein contained, and an entirely new and additional combination which was never passed upon by the patent office and which Wilson never claimed to have invented.

This court has not followed the District Court in the full extent of its "creative excursion," but has failed to distinguish between *what is* and *what is not* within the terms of claims 9 and 19 *and has gone afield into a discussion of other elements and features in no wise found in either claim 9 or 19 and not before this court.* Indeed, the greater part of the opinion appears to be a discussion of the distinctive features of "Type F" and a showing of points of similarity between that and the Wilson reamer, matters entirely outside of the combinations of claims 9 and 19.

Having devoted the principal part of the opinion to "Type F," which in all of the particulars especially

emphasized is entirely different from any other Double reamer, the court makes the mistake of treating this discussion of "Type F" as fairly disposing of the really important devices which the discussion does not at all involve.

If "Type F" alone were the item of infringement before the court, there would be no practical advantage to the Union Tool Company in prosecuting this litigation because so few of these reamers have been marketed and at such expense that "Type F" is negligible. Defendant made only 65 "Type F" reamers, yet it made over 4900 "Double Improved," approximately 200 "Type D," and two (2) "Type E" reamers. Instead of the "Type F" reamer being the issue of importance, the important constructions have not been considered. When, however, the features of "Type F," which are not common to any other type, are made the occasion for condemning each of the other types without any discussion whatever or apparent appreciation of the fundamental differences, we respectfully direct the attention of the court to this oversight and to the necessary injustice resulting therefrom.

8. When the definite boundaries of the Wilson monopoly under claims 9 and 19 are fixed,—in the light of the Wilson "mode of operation" as distinguished from that of Double and others,—it will be clearly seen wherein the District Court went astray in holding that without at all using the Wilson "mode of operation" or any Wilson "combination," and while retaining the Double "mode of operation," Union Tool Company still was guilty of infringement.

Because this analysis of the plain and obvious meaning of claims 9 and 19 should not admit of serious mechanical dispute, but apparently has eluded the Honorable District Court and has not been so presented to this court as to receive the consideration which we submit it demands as a controlling factor of the case, it is evident that there is ample reason why we should undertake to remedy in this petition what must have been our previous fault in presenting this simple yet all-important subject.

**Failure of Court to Apply in Its Decision Herein
Rule of Construction Announced and Applied
in Its Decision Contemporaneously Rendered
in the Companion Case No. 2996.**

In the opinion herein, defendant-appellant's Type F underreamer is discussed at length and its structural features compared with the structural features of the respective combinations covered by claims 9 and 19 of the patent in suit. In view of such elaborate consideration of Type F, we refrain from requesting the court to again direct its attention thereto.

In view of the obvious fact that Type F, in form and appearance, much more closely resembled *in looks* the device, disclosed in the Wilson patent in suit, than did defendant's other types of underreamers respectively designated in the record as types D and E and "Double Improved," which in no wise resemble it, it was good strategy, on the part of opposing counsel, to devote most of his attention and, thereby, direct the court's attention, in the main, to said Type F device, which is of negligible consequence.

By reason of the court's opinion almost exclusively dealing with Type F, we feel that the question of infringement, in respect to said Types D, E and "Double Improved," has not received the attention its importance deserves.

In its opinion in the companion case No. 2996, brought by the defendant-appellant herein against the Wilson-Willard Manufacturing Company, this Honorable Court says:

"It must be held that the Double patent should be strictly construed and the patentee, having limited himself to the elements of his combination, is limited in the construction of his claim to the device shown. *Oriental Tissue Co. v. Louis De Jonge & Co.*, 235 Fed. 296. The importance of this point is emphasized by the record which shows that Double cancelled his claim No. 8 and substituted claim No. 7, limited his specification and amended his claims to provide for opposite parallel bearing faces upon his hollow slotted extension. *He thus eliminated from his claims those things which were excluded by surrender of scope and of definition of his claimed combination.* *Wright v. Yengling*, 155 U. S. 47; *Roemer v. Peddie*, 132 U. S. 313; *Green v. Buckley*, 135 Fed. 520." (Italics ours.)

The well established rule of claim construction, so referred to, is expressed, by the Supreme Court in said case of *Roemer v. Peddie*, as follows:

"This court has often held that when a patentee, on the rejection of his application, inserts in his specification, in consequence, limitations and restrictions for the purpose of obtaining his patent,

he cannot, after he has obtained it, claim that it shall be construed as it would have been construed if such limitations and restrictions were not contained in it."

In the companion case, No. 2996, such rule is applied to the *disadvantage of the defendant-appellant herein*.

We respectfully submit that such rule is more applicable to the facts of this case and should be applied herein *to the advantage of the defendant-appellant*.

In the case at bar, as a necessary basis for the finding of infringement thereof by Types D, E and "Double Improved," claims 9 and 19 of the Wilson patent in suit, must be construed as covering *the prior patented Double underreamer body and extension* plus projecting lugs thereon to hold the cutters apart, because each of said underreamers, in fact, does embrace such prior Double underreamer body and extension, and not the Wilson "*body terminating in prongs forming a fork.*"

The question presented by such finding is whether said claims can be properly so construed in view of the Wilson file wrapper, wherein it appears that the patentee, Wilson, in his application, as originally filed, attempted to cover just such a combination of *the prior patented Double underreamer body and extension plus projecting lugs thereon to hold the cutters apart* and his claims thereon were rejected.

In other words, some of Wilson's original claims covered any kind of an underreamer body plus projecting lugs at the mouth thereof to hold the cutters apart and *said claims were rejected*.

The patentee, Wilson, was unable to convince the patent office that he was entitled to a claim covering the downwardly projecting lugs and cutters having bearings on their respective bodies engaging such lugs *except in combination with his specific type of under-reamer body, as specifically distinguished by him from precisely the same body formation found in each of said Types D, E and "Double Improved."*

We, therefore, respectively submit that an application of such rule of claim construction, announced by the court in the companion case, prevents claims 9 and 19 being construed to cover Types D, E and "Double Improved."

As the lower court's decision, finding infringement by Types D, E and "Double Improved," is affirmed by this court without any discussion of such question of infringement by said types, we assume that this court adopts and approves Judge Cushman's line of reasoning prompting him to make such decision. We, therefore, shall consider his views on this question.

In the opinion of the lower court herein, His Honor, Judge Cushman, said:

"Passing to claims 9 and 19, it has already been found that, as ways for the cutters to slide or ride on, the faces of the prongs and lugs were no more than equivalents of the ways found in the Double invention; but insofar as these prongs or lug faces afford bearings for the cutter when in reaming position is concerned, a different question is presented, and *this is the feature covered by claims 9 and 19.*"

In order to clearly define and describe the “*feature*” covered by said claims, Judge Cushman proceeds to state:

“In the machine of the Double patent and original design, the slotted web of the lower extension helped to form a pocked for the cutter and furnished the intrust and outthrust bearing for the cutter shanks and extended to the very bottom of the reamer body. This, necessarily, resulted in two things: an inner bearing for the cutter head, narrow as compared with the diameter of the extension upon the reamer body, and weakened to some extent by the slots therein. In the patent in suit, the lower portion of the outer web is cut away, giving the cutter less lateral and greater intrust bearings. The lugs on either side are thereby created. The outer faces of these lugs form bearings for the inner shoulders on the cutters. This formation enables the maker—because of the removal of the side web—to give the cutters a wider inner face and inner bearings at the outer side of the inner face of the cutter.”

The “*feature*” covered by claims 9 and 19, according to Judge Cushman’s construction thereof, resides, therefore, in the provision of the *lugs 2" projecting at the sides of the lower end of the underreamer body to hold the cutters apart.*

Of course, if such “lugs” hold the cutters apart, when in reaming position, such cutters must necessarily have *bearing* faces co-operating with the *bearing* faces on the lugs. In other words, the presence of such “lugs” in an underreamer, for the purpose of holding



WILSON'S
PRONGED BODY
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apart the cutters therein, necessarily implies the presence of cutters having bearing faces co-operating with the bearing faces on the lugs, otherwise the lugs could not hold them apart.

According to Judge Cushman's construction of claims 9 and 19, said claims should not be limited to the specific details of construction therein specified and constituting the "body" portion of the underreamer, because, as he says in substance, the "*feature*" covered by these claims does not reside in the "*body*" portion, *but in the lugs projecting therefrom and co-operating with bearings on the cutters.*

According to our interpretation of Judge Cushman's opinion, it is a finding to the effect that the invention covered by claims 9 and 19, is the combination with "*any kind of an underreamer body*" of lugs projecting from the lower end thereof to hold the cutters apart.

Furthermore, in finding said claims 9 and 19 infringed by defendant's underreamers, Types D, E and "Double Improved," we respectfully submit, that this court, as a basis for such finding, necessarily construes said claims as covering "*any kind of an underreamer body*" provided with lugs projecting from the lower end thereof to hold the cutters apart.

On the opposite page are photographs respectively disclosing Types D, E and "Double Improved," held to infringe claims 9 and 19. With the exception of the so-called lug elements, formed at the lower ends of the respective bodies of said underreamers *by shearing away the side web of the extension*, said underreamers, so far as concerns any elements of said claims 9 and

19, are substantially identical with the underreamer body and extension disclosed in figure III of the prior Double Patent, No. 748,054. [R. p. 983.] As said by Judge Cushman:

“In the earlier Double devices there were secondary dovetails adjacent to the junction of the cutter head and shanks, with corresponding ways in the inner faces of the extension, forming the recess in which the cutter is mounted on the body. These added ways caused an outward flare at the mouth of the recess or pocket. As these were made deeper and the flare increased, a wider bearing would be given, and opportunity for a wider faced cutter to bear upon it; *but when defendant departed from this form of construction, and entirely sheared away the side web of the extension to form a lug, the bearing faces to accommodate the wider cutter head, he appropriated the invention and conception of Wilson and particularly of the patent in suit.*”

So far as concerns Types D, E and “Double Improved,” the *only change* made in the prior Double patented “*body and extension*” was, in the language of Judge Cushman, to shear “*away the side web of the extension to form a lug, the bearing faces to accommodate the wider cutter head.*”

The effect of such “*shearing away of the side web*” was merely to provide said *prior Double body and extension* with “lugs to hold the cutters apart” by means of the bearings on such lugs co-operating with the bearings on the cutter heads.

Therefore, in combining with or adding to such prior Double patented body and extension, said lugs to form

bearings co-operating with bearings on the cutter heads, defendant, according to Judge Cushman, appropriated Wilson's invention and infringed claims 9 and 19.

In so finding said claims infringed by Types D, E and "Double Improved," Judge Cushman necessarily construed said claims as covering the "prior patented Double body and extension" plus "lugs thereon for holding the cutters apart," notwithstanding the patentee Wilson endeavored to secure claims, *on their face*, of a corresponding breadth and scope, *but failed*.

The Wilson patent application, as originally filed, and as amended from time to time, contained a number of claims which, *on their face*, obviously covered just such a combination as the "prior patented Double body and extension" (as embodied in Types D, E and "Double Improved") plus *lugs thereon to hold the cutters apart*.

These broad claims were rejected and narrower claims, *limited to the Wilson specific form of body formation* plus said lugs, were substituted therefor.

A copy of the Wilson patent file wrapper appears in the record, commencing at page 1023 thereof.

Some of the claims in the Wilson application, as originally filed, read as follows:

"1. An underreamer having *projecting lugs at its mouth* for expanding cutters.

"2. An underreamer provided with upper and lower bearings for its expanded cutters, the lower bearing being formed of *lugs projecting at the mouth of the reamer*.

"3. An underreamer having cutter bearings for the downthrust and bearings for expanding the

cutters, the latter being formed of *projecting lugs at the mouth of the reamer.*

“11. An underreamer having lugs at the lower end of its body to hold the cutters apart.” [R. p. 1031.]

It is perfectly obvious that each of said claims 1 and 11 accurately and comprehensively cover the “feature” referred to by Judge Cushman as being covered by claims 9 and 19 and residing in the “lug faces” to afford “bearings for the cutters when in reaming position.” These claims cover said “feature broadly because they are not limited to the details of construction of any particular or specified underreamer body.

Said claims 1 and 11, not being limited to the details of construction of any particular or specified underreamer body, cover Types D, E and “Double Improved.”

However, said broad claims were rejected by the patent office. The reason for such rejection is obvious. In the opinion of the patent office, Wilson was not entitled to cover such “feature” broadly, but only in combination with a particular or specified type of underreamer body, to-wit, the Wilson body “terminating in prongs.”

Furthermore, the Wilson patent file wrapper shows that the patent office was unwilling to permit Wilson to cover said “feature” in combination with the “prior patented Double underreamer body,” which is embodied in each of said Types D, E and “Double Improved.”

Furthermore, the Wilson patent file wrapper shows that Wilson acquiesced in the patent office rulings and

specifically committed himself to an interpretation of his claims which excludes the combination of said “prior patented Double body and extension” with said “feature” residing in said *projecting lugs to hold the cutters apart*.

The plaintiff-appellee, under said rule of claim construction announced by this Honorable Court in the companion case, is estopped from insisting on a construction of claims 9 and 19 which accords them a scope sufficient to embrace said specific construction so relinquished by Wilson in order to secure his patent.

In order to secure an allowance of claims 1, 2 and 3, Wilson finally amended them so said “feature” of the projecting lugs forming intrust bearings for the cutters, was claimed only in combination with his specific type of underreamer body.

As so amended, in order to secure their allowance, each of said claims, in the patent, is limited to the combination of said “feature” with an underreamer body “*terminating in prongs*.”

In order to clearly show that by said *limitation “terminating in prongs,”* the prior patented Double underreamer body (which is embodied in Types D, E and “Double Improved”) was *excluded* and *not to be included* within the scope of any claim so limited, the patentee Wilson presented to the patent office, by way of inducing the patent office to allow his claims, the following argument, which includes, in the language used by this court in the companion case, a “*surrender of scope and of definition of his claimed combination*.”

It is to be noted that the said argument, about to be quoted, was made *after* Wilson had amended his original broad claims 1, 2 and 3 by limiting each of them to a body "*terminating in prongs,*" and after he had amended his original claim 4 so as to limit it to a body "*terminating in prongs forming a fork.*"

Wilson's said argument and "*surrender of scope and of definition of his claimed combination*" necessarily applies with equal force and effect to each and every claim, limited to a body "*terminating in prongs.*" Such argument and "*surrender*" read as follows:

"I request reconsideration and allowance of claim 4 for the reason that Double 748,054" (disclosing form of body in Types D, E and Double Improved) "does not show a cutter body terminating in prongs forming a fork. Upon the contrary, the Double body is provided with a web 6 on each side of which are recesses 4 and 5, there being a slot 7 through the web. The Double underreamer body of No. 748,054 clearly does not anticipate claim 4 which is limited to the 'body terminating in prongs forming a fork.'" [Transcript Record, p. 1047.]

Claims 9 and 19 are likewise each limited to a body "*terminating in prongs.*"

In view of Wilson's said "*surrender of scope and of definition of his claimed combination,*" can said claims be properly construed to cover that which Wilson *so specifically surrendered and excluded from the scope of his invention?* However, they must be so construed in order to have them cover Types D, E and "Double Improved," each of which embraces the *form of body*

disclosed in said Double patent No. 748,054 so specifically referred to by Wilson in his "*surrender of scope*" and each of which embraces said "*web 6 on each side of which are recesses 4 and 5, there being a slot 7 through the web.*"

Aside from the foregoing estoppel preventing claims 9 and 19 being properly construed to cover Types D, E and "Double Improved," said claims should not be construed to cover said types, because not one of them is the mechanical equivalent of either of the combinations respectively covered by said claims, nor does any of said types possess the numerous advantages inherent in the said combinations.

The following facts are true in respect to each of said Types D, E and "Double Improved":

1. Advantage of assemblage from bottom *not present.*
2. Advantage of remachining feature *not present.*
3. Advantage of close collapshion of cutters *not present.*
4. Advantage of having more stock in cutters *not present.*
5. Advantage of having maximum open space between cutters *not present.*
6. Advantage of use of solid tee *not present.*
7. Advantage of requiring nothing except prongs and cutters and upthrust on the body in all of the underreamer expanding, collapsing and working actions and strain resistances, *not present*, as web 6 essential to operativeness of Types D, E and "Double Improved."

All the foregoing advantages are inherent in the respective combinations of claims 9 and 19. The question naturally presents itself: When does the invention embodied in a claimed combination of elements cease to exist? In the construction of a claim, in reference to an alleged infringing device, what is to be deemed the "*vanishing point*" of the claimed invention?

In the present case, it is a simple matter to determine such "*vanishing point*."

The advantageous "feature" embraced in the projecting lugs to hold the cutters apart by means of bearing faces on the lugs co-operating with bearing faces on the cutter bodies, when in reaming position, was attempted to be covered broadly, that is, in combination with *any kind of an underreamer body*. Such attempt was made by Wilson when he inserted, in his application, claims I and II, reading as follows:

"I. An underreamer body having projecting lugs at its mouth for expanding cutters.

"II. An underreamer having lugs at the sides of the lower end of its body to hold the cutters apart."

The said claims were rejected. Wilson acquiesced in such rejection. Wilson thereby admitted and conceded that he was not entitled to claim, as his invention, the "feature" embraced in and the "*advantage*" inherent in the "*lugs projecting at the sides of the mouth of the underreamer body to hold the cutters apart*."

His "*surrender of scope*" of invention was specifically recorded by his amendment of claim I to limit it to a combination of said "*projecting lugs*" with his

specific form of underreamer body, to-wit, a "*body terminating in prongs.*"

In other words, Wilson, in response to the actions of the patent office and in order to secure and as a condition precedent to securing an allowance of his application, conceded and admitted and agreed that, so far as the "*feature,*" embracing said lugs with bearings thereon co-operating with bearings on the cutters to hold them apart, was concerned, his invention resided in combining said "*feature*" with his specific type of underreamer body, to-wit, "*one terminating in prongs,*" and that his invention did not reside in or include the combination of said "*feature*" with other types of underreamer bodies. The prior art compelled such a "*surrender of scope*" of invention.

The O'Donnell and Willard patent [R. p. 1004] discloses an underreamer body and lugs projecting at the sides of the mouth thereof and extending laterally on either side, *beyond the mouth opening.* Each of the two cutters in this patent has a head *wider than the mouth,* and on the cutter head is a *bearing, extending laterally, on either side, beyond the mouth opening,* and co-operating with the bearings on the lugs. Of course, there is only one continuous bearing, extending clear across the cutter head, and co-operating with the bearings on the lugs. However, there is only one such continuous bearing on each of the cutters in Types D, E and "Double Improved" and *not two separate, distinct* bearings respectively located on two shoulders of the cutter *as in the Wilson device.* Furthermore, the O'Donnell-Willard underreamer body

is not of the Wilson type "terminating in prongs." However, the respective bodies of Types D, E and "Double Improved" are not of such Wilson type, "terminating in prongs." In its decision in the companion case, this court has found that the O'Donnell-Willard underreamer was a successful device.

Wilson went even further in his surrender, concession and admission. He specifically stated and conceded that the "prior patented Double underreamer body" (as embraced in Types D, E and "Double Improved") was not a "body terminating in prongs" and, therefore, unqualifiedly excluded the same from his "*definition of his claimed invention.*"

In view of the foregoing, it is apparent that, in respect to any claim in the Wilson patent, including said "*feature*" in combination with the *Wilson type of underreamer body*, the Wilson invention, covered by said claim, ceases to exist when we construe out of or exclude from said claimed combination those elements constituting the Wilson type of underreamer body.

In other words, so far as concerns said "*feature*," the "*vanishing point*" of the Wilson invention is reached when we isolate or separate said "*feature*" from the Wilson underreamer "*body terminating in prongs.*"

Wilson admitted and conceded his invention resided in associating said "*feature*" with his *particular type* of underreamer body and that, when associated with *other types* of underreamer bodies, particularly said prior Double type of patent No. 748,054, he could lay no claim to it. The proof of such fact and "*surrender*

of scope” is in his *cancellation* of the claims attempting to cover such “*feature*” when combined with types of bodies, other than his own specific type, “*terminating in prongs.*”

We respectfully submit that, in finding claims 9 and 19 infringed by said Types D, E and “Double Improved,” this Honorable Court has overlooked Wilson’s said “*surrender of scope*” of his invention and has failed to apply the rule of claim construction, above referred to, and which is controlling in respect to the foregoing facts.

By a mere glance at said Types D, E and “Double Improved” it is apparent that not one of said types embodies a single advantage inherent in the Wilson combinations of claims 9 and 19, other than that inherent in the lugs projecting at the lower end of the body to hold the cutters apart.

If said claims be so construed as to cover an under-reamer body not of the Wilson type “*terminating in prongs,*” then said claims are necessarily given a scope commensurate with that of the claims cancelled by Wilson in order to secure his patent.

We respectfully submit that when said claims 9 and 19 are accorded a scope sufficient to cover Types D, E and “Double Improved,” they are being accorded a scope commensurate with that of such cancelled claims.

In the first suit, A 4, brought against the defendant-appellant, by election only claims 16 and 17 were charged to be infringed by said Types D and E and “*Double Improved.*” It will be noted said claims do not include, as an element thereof, Wil-

son's "*body terminating in prongs.*" Said two claims, and claim 6, are the only claims in the Wilson patent which do not include said "*body terminating in prongs.*"

The fact that, at the commencement of this litigation, none of said claims, limited to such specific type of body formation, were charged to be infringed, clearly indicates the views and opinions of the opposing party that defendant's devices did not embrace any such "*body terminating in prongs,*" and, therefore, none of said claims, so limited to such type of body, were infringed. It was only after Type F was put on the market that the other claims of the Wilson patent were charged to be infringed by it.

Seventeen out of the twenty claims of this Wilson patent are each, *on its face*, specifically limited to an underreamer body "*terminating in prongs.*" If said limitation is to be ignored in respect to any one of these claims and such claim held to cover an underreamer having a body *not "terminating in prongs,"* such as Type D or E or "*Double Improved,*" on what ground or under what rule of claim construction, or under what principle of law, should said "*limitation*" be respected or enforced in the construction of any of the other sixteen claims having such limitation expressed therein?

We respectfully submit that if such "*limitation*" be ignored in respect to any one of said seventeen claims, there is no logical reason for treating it as a "*limitation,*" *in fact*, in respect to any of the other sixteen claims, containing a like "*limitation.*"

The foregoing is merely suggested by way of questioning the correctness of any construction of claims 9 and 19 which accords them a scope entirely and completely inconsistent with such limitation contained in each of them, and which scope is necessary in order to enable them to cover Types D, E and “Double Improved.”

We respectfully submit that the court, in construing claims 9 and 19 to cover Types D, E and “Double Improved,” has failed to apply the said *controlling rule of claim construction* announced in the opinion rendered in the companion case 2996, and, therefore, a rehearing of this cause is respectfully prayed.

Claims 9 and 19 Clearly Limited by Their Plain Terms.

The District Court found that claims 9 and 19 of the Wilson patent have been infringed, not only by the “Type F” underreamer, but also by the “Double Improved” and Types D and E, and *bases this decree upon the bill of complaint in “B-62.”*

The infringement found by the District Court consists in “cutting away the side web to give the cutter greater bearing.” [Record p. 78.]

Claims 9 and 19 which alone are now before this court read as follows:

“9. An underreamer body terminating in prongs forming a fork and provided with shoulders on the inner forks of the prongs which form cutter-ways and terminate in downwardly projecting lugs, and cutters mounted between the

prongs of said fork and having shoulders inside the fork and faces to bear on the projecting lugs.

“19. An underreamer comprising a body terminating in two prongs and cutters each having two shoulders, and the bearing face on the inner side of each of the two shoulders to engage said prongs.”

It is no less than astonishing that the District Court should have undertaken to expand and enlarge the plain and unambiguous language of claims 9 and 19, so as to create an entirely new and independent element of discovery not found nor attempted to be expressed in either of these claims.

Simple Analysis.

Each of these claims its right to patent solely upon the *combination* therein described.

The combination in claim 9 is made up of:

(a) An underreamer body terminating in prongs forming a fork;

(b) And provided with shoulders on the inner faces of the prongs which form cutter-ways and terminate in downwardly projecting lugs;

(c) And cutters mounted between the prongs of said fork and having shoulders inside the fork and faces to bear on the projecting lugs.

Unless all of these three elements are found the combination amounts to nothing, because the constituent parts separated from their inter-relation are not claimed as either new or novel. They were old, separately considered, and the fact that they are claimed in

combination admits in law that each of the separate parts are old.

What is there that requires judicial interpretation or construction in claim 9?

It is admitted, and indeed was urged by appellee Wilson both to the patent office and in the court below, that the Double type of underreamer does not terminate in prongs forming a fork, and it was upon Mr. Wilson's representations to the Patent Office that the Double reamer did not terminate in prongs forming a fork that these claims were allowed.

This is distinctly asserted by Mr. Wilson as the characteristic point of difference between his invention and that of Double's and appears in his arguments to the patent office itself. [Record p. 1047.]

Since there are no prongs it cannot be claimed that the Double underreamer is provided with shoulders on the inner faces of the prongs or that such shoulders or prongs have "formed cutter ways" or "terminate in downwardly projecting lugs," but decidedly it is not claimed that any Double underreamer has "cutters mounted *between the prongs* of said fork" or "having shoulders *inside the fork and faces to bear on the projecting lugs.*"

It requires nothing whatever more than a bare reading of this claim 9 to show wherein it differs in every respect in "mode of operation" from any said types of the Double reamer.

Claim 19: If claim 9 is clear and explicit and if the combination which alone is therein claimed to be novel has not been infringed by what process of

artificial interpretation can claim 19 be said to have been infringed by any Double reamer.

ANALYSIS: Claim 19 describes but a *combination*. It must be an “underreamer” comprising

(a) A body terminating in *two* prongs;

(b) And cutters each having *two* shoulders and a bearing face on the inner side of each of the two shoulders to engage said prongs.”

The prongs are thereby described as being necessarily separated because there are *two* of them, and each of the two cutters must have *two separate* shoulders, and there must be a *bearing face* on the *inner side* of each of these *two* separate shoulders “*to engage the prongs.*”

By the greatest stretch of the imagination and applying the language here used to the Wilson reamer and the sketches furnished, and the language employed in the remaining parts of the patent and especially to the “mode of operation” without which this language cannot be properly understood, we have the proposition that two prongs as here used can have no legitimate meaning except the same kind of prongs and prongs performing the same functions *in combination* as are shown in the Wilson type of reamer.

The word “prongs” is not occult, nor a word that can be made to have a fast or loose meaning according to the varying whims of the inventor. It cannot mean one thing at the time of the invention and for six or eight years thereafter, and take on a new meaning to accommodate the stress of a law suit. The Wilson pronged reamer, instead of having a *continuous* bear-

ing for its cutters, has its cutters swung between the prongs and this claim distinctly asserts that the cutters rest upon the *two separated bearings*, whereas the Double reamer has a *continuous bearing across the entire inner face* and upon which its cutters rest. Thus one is a *pronged* structure and the other is a continuous or non-prong structure, and any holding by the District Court to the contrary is a creation by the court of a new element not found in the patent and a flying in the face of known and positive mechanical differences.

III.

That This Court Has Fallen Into a Misapprehension as to the Issues Raised by the Pleadings in the Two Cases A4 and B62.

Claims 16 and 17 in case "A-4," and "Type F" only in case "B-62" were before the District Court. There was an obvious mistrial by the District Court of the issues presented by the pleadings and the record in the consolidated cases "A-4" and "B-62."

A bare statement of the bare facts should suffice to demonstrate this situation.

The District Court ordered a decree for defendant in A-4. [Record p. 69.] The injunction appealed was ordered under suit B-62. [Record p. 79.]

The record shows that for years prior to the beginning of suit "A-4" Wilson and his attorney were entirely familiar with all the details of each and all of the Double reamers, saving only "Type F," which had not then been designed.

With this technical and actual knowledge, case "A-4" was begun in February, 1913. In a formal way it was charged that the several Double reamers manufactured by Union Tool Company infringed each and all of the 20 claims of the Wilson patent.

In March, 1913, plaintiff's attorney deliberately and for the purpose of intentionally narrowing the controversy and the evidence which he would be required to produce, announced upon the record that Wilson elected to stand upon claims 16 and 17 and no others. [Record p. 121.] This election, so made with full knowledge of all of the facts, is not only persuasive evidence that neither Wilson nor his able attorney had the slightest notion that claims 9 and 19 could be tortured into covering what the District Court expanded them to cover,—but it was sufficient warrant for Union Tool Company to continue with absolute immunity to manufacture and sell its existing types of reamers in reliance upon such election and admission, and without any liability to account for the same otherwise than with reference to claims 16 and 17, which related to the cutters only.

About November, 1914 (when complainant's *prima facie* case was nearly closed), Wilson learned that some time in 1914 Union Tool Company had brought out its "Type F" reamer, which Wilson claimed infringed not only claims 16 and 17, but various other claims of his patent.

The discovery that the new "Type F" Double reamer had been placed on the market was the sole and only reason or excuse for the new case—"B-62." Much

illumination is found in the record upon this subject. If Wilson desired so to do he could have filed a supplemental bill in "A-4" for matter which arose after his election. This he feared to do, because, if he failed to establish the infringement of claims 16 and 17, then his supplemental bill would also fail because it could not stand alone and independently of the valid, original claim. To remedy this, he finally determined to begin a new action as "B-62" for no other purpose whatever than to perform the same function as would a supplemental bill, and charge the infringement resulting from the new "Type F" Double reamer,—without in any wise retreating from or modifying his election made in March, 1913, to stand upon claims 16 and 17 as to all then existing types.

It is fairly obvious and elemental that, having begun his action "A-4," originally covering and charging infringement of each and all of the 20 claims of the Wilson patent, he could not split that action by beginning a new action against the same party in the same court and relating to the same patent and the same types of reamer which he had charged in the original action to infringe his patent. The only remedy, *if he changed his mind*, would have been to take steps to relieve himself upon the record of his election in "A-4." It is absolutely certain that he could not confirm this election in "A-4," and then in effect avoid it by beginning "B-62" and so phrasing his bill of complaint as to cover not only the new "Type F," but also to reassert each and all of the items of infringement which he had abandoned in case "A-4."

But Wilson made no effort in the beginning of "B-62" to dodge his election, but, on the contrary, confirmed it, and the record clearly shows that his only claim and purpose in "B-62" related to the "Type F" Double reamer.

His original bill of complaint in "B-62" was so drawn as to be almost identical with that in "A-4," notwithstanding his declaration upon the record that he was intending to cover the "Type F" form only.

Thus two suits practically identical in form were attempted to be planted in the same court between the same parties and relating to the same matter.

A motion to dismiss was filed by Union Tool Company. The attorney for Wilson, to meet this motion, filed an amendment in "B-62" and expressly stated to the court in that connection [Record p. 513]:

"An original bill has been filed alleging infringement of certain claims of the patent in suit, other than the claims involved in the election charging infringement in this case ('A-4'). It is the present purpose of complainant to move this Honorable Court for an order consolidating the suit thus filed, involving this patent subsequent to the present suit, with the present suit, upon a showing that the issue of such subsequent suit involves exhibit Plaintiff's Exhibit Reamer Type 'F' in this present or first brought suit, and in order that, as to such exhibit, the issues of infringement under the patent in suit may be broadened out in the respects of such further bill. *We have attempted to dodge the election made in this case.*"

This is a plain, straight-forward statement of the situation and was followed by an amendment which in the very amended bill itself in "B-62" asserts as the reason for this amended bill the election to stand upon claims 16 and 17 of this patent in suit "A-4,"—which election would not, of course, apply to a newly constructed device which constituted an infringement after the making of such election. Thus the effect of the election is not only found in the record, but is embalmed in the very pleadings themselves.

Under date of December 19th, 1914, before "B-62" was begun, we find Mr. Blakeslee declaring [Record pp. 437-438]:

"The complainant finds it necessary, in order to make out a full case of infringement against the defendant to take proper steps to depart from the election heretofore made as above recited. *That election we are prepared to stand by with respect to the alleged infringing structures other than Complainant's Exhibit Defendant's Reamer Type F.'*"

There is much discussion following and it is specifically stated over and over again that "B-62" was to bring "Type F" reamer before the court and not to dodge the election as to reamers existing at the beginning of "A-4."

Expressly basing the application upon the record thus made, in "A-4," a consolidation of these two cases was had and the cases were tried and pleadings were in no wise changed or attempted to be changed, and there never was any attempt by the complainant to obtain

relief from the election so made and repeatedly confirmed and carried into the pleadings.

On July 23rd, 1915, Mr. Blakeslee, in the taking of testimony and without in any wise referring to his election in "A-4," stated:

"Complainant gives notice to the defendant at this time that *alternative to any disposition* which may be made of equity suit No. 'B-62,' consolidated by the order of the court with equity suit No. 'A-4,' consolidated, in which these proceedings are being conducted, namely, any disposition which may be made of said equity suit No. 'B-62' at the final hearing of this case with respect to such consolidation of said two cases, complainant at such final hearing will rely upon claims Nos. 2, 4, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, and 19 of the Wilson patent in suit herein. This notice of alternative attitude or position is given at this time in order that defendant may be apprised in the premises before commencing the taking of its proofs." [Record page 541.]

(Note. This statement is erroneously quoted in Judge Cushman's opinion, pages 81-82 of the Record.)

This notice relates to "B-62" and nothing else. Indeed, it is in no wise intended to withdraw the election made in "A-4" and so never was construed by the District Court, and surely it would not lie in the mouth of Mr. Blakeslee to create new and different issues as to any other types except "Type F" in "B-62" by a mere statement of this character. There is no word in this statement indicating that the declar-

ation found on page 513 of the record that “B-62” relates to “Type F” only and the declaration found on page 517 of the record to the same effect were in any wise intended to be withdrawn and if it were attempted by this method to run into “B-62” all of the other types of reamers, that fact would naturally have been expressed.

What does Mr. Blakeslee mean by the words “alternative to any disposition” or “this notice of *alternative attitude*”?

It seems to us that, inasmuch as he does not refer at all to his election or to the types of reamers, he must have had in mind the fact that Judge Bledsoe reserved to the defendant the right to again raise the point of consolidation of the cases after the testimony had been all taken and that Blakeslee was giving notice that, in determining that question, he expected in “B-62” to rely upon the several claims as indicated, for he says:

“Alternative to any disposition—which may be made of said equity suit No. ‘B-62’ *at the final hearing of this case with respect to such consolidation of such two cases.*”

In other words, that if the cases should not be finally consolidated, then he expected that as to the “Type F” reamer, particularly charged in “B-62,” he would rely upon each and all of the claims of infringement mentioned, and all of the testimony which had been taken in the consolidated cases should be so considered in determining finally what should be done on the subject of consolidation if the matter should again be brought up by the defendant. If this statement does not refer

to this matter it is absolutely blind and without point, and, in any event, it cannot vary the issues in either of the cases.

Since the consolidation was had on the faith of the pleadings and record in "A-4," it would have been a fraud upon the court if "B-62" under the amended bill of complaint was intended to "dodge the election" referred to in the amended bill itself by covering not only "Type F," as declared by Wilson's attorney, but by splitting the claims as to the types existing when action "A-4" began and re-asserting a part only of these claims in case "B-62." No such fraud was intended in our judgment, and the record does not disclose any such purpose,—but this is true because the purpose actually disclosed was to stand by the election made in "A-4" as to all types of reamers existing at the beginning of "A-4" and to begin "B-62" to cover "Type F" only. That was the state of the pleadings February 8, 1915. *The consolidation created no new issues. The pleadings were not changed thereafter.*

The District Court held that "A-4" covered and was restricted to claims 16 and 17, but erroneously held that "B-62" not only covered "Type F," but also all the other Double reamers which formed the cause of action in "A-4," and thus in effect held that in the beginning of "B-62" an effective fraud had been perpetrated upon Judge Bledsoe in making "B-62" "*dodge the election*" and relate to each and all of the types of reamers referred to in case "A-4" as well as to "Type F," which Judge Bledsoe was solemnly assured was the only type covered or attempted to be covered in case

“B-62.” We submit that if Wilson desired to avoid his election in “A-4” he could not do it by beginning a new action as to a portion of the claims therein originally referred to and that therefore the court cannot “*dodge this election*” for him by doing for him what he could not do himself and what he has in no wise asked the court to do.

The result of this situation is that upon the pleadings and the record in “A-4,” the case covered the Double underreamers existing at the time “A-4” was begun, and that, although the original bill of complaint charges infringement of all 20 claims, complainant elected to stand upon claims 16 and 17 only, and the case was tried upon those issues and the complainant was defeated, thus disposing of all of the issues that were ever before the court in “A-4.” In “B-62” there was no excuse for the case whatever except that the election which was expressly reaffirmed in the pleading in “B-62” did not apply to “Type F,” and they desired to litigate out the subsequent infringement claimed on account of “Type F” as to all claims except 16 and 17; which were already covered in “A-4.” Thus “Type F” only could possibly be involved in “B-62,” and, since the District Court found against the complainant as to all claims except 9 and 19 in “B-62,” this appeal presents to the District Court nothing whatever except claims 9 and 19 under the pleadings in “B-62” and relating to no other types of reamers than the “Type F” reamer which alone could be the subject of litigation in case “B-62.”

The “Double Improved” and Type D and E reamers were not before the court except as charged in “A-4” to infringe claims 16 and 17, and the decree has no foundation on which it can be supported.

SUMMARY.

First: The plain state of the pleadings as well as the record limited the inquiry of the District Court

(a) To claims 16 and 17 under the bill of complaint in case “A-4”.

(b) To the “Type F” underreamer, under amended bill of complaint in case “B-62”.

The District Court, missing the true point here involved, erroneously expanded “B-62” beyond the issues therein tendered by the amended bill.

This court has, we submit, failed to examine or really to pass upon this question. The controlling factors thereof are ignored.

There has therefore been a mistrial (or no trial) upon this pivotal point.

Second: If the amended bill of complaint in case “B-62”—construed in the light of the record—presents any claimed infringement, excepting only the alleged *new* cause of action arising because “Type F” was brought out long after case No. “A-4” was begun—*then the District Court manifestly erred in not sustaining the motion to dismiss because another action was pending covering the same subject matter, the same patent and between the same parties and in the same court.*

IV.

This Court Has Found the Double and Wilson Reamers Different in Principle and Operation and Non-Equivalent and One Cannot Infringe Upon the Other.

In the opinion of this court in the companion case, No. 2996, Wilson & Willard Mfg. Co. v. Union Tool Co., this court compares the Double reamer with the Wilson reamer and says (page 6):

“The devices operate upon different principles and under different modes of operation.”

The Double reamers, Types “D,” “E,” and “Double Improved” have identically the same principle and the same mode of operation as the Double reamer thus referred to by this court. If this court be correct in this finding it follows infringement cannot be found in this case.

As said by this court in Riverside Hts. O. G. Ass’n. v. Stebler, 240 Fed. 703, at page 709:

“But there is a further rule also applicable to this question, and that is:

“‘If the device of the respondents shows a substantially different mode of operation, even though the result of the operation of the machine remains the same, infringement is avoided.’ Cimiotti Unhairing Co. v. American Fur. Ref. Co., 198 U. S. 399.”

The lower court, in case No. 2996, held the principles and mode of operation of the Double and Wilson reamers to be substantially the same. Deducing from this finding a similarity of principle and of mode of operation in the two reamers, the Double and the Wilson, the District Court then found infringement of the Wilson patent. This court, having reversed this finding of the lower court, cannot consistently hold that the principles and modes of operation of the Wilson and Double reamers are both the same and different. It is respectfully submitted that the findings in these two cases should be consistent as to the mechanical structures referred to.

In the decision in case No. 2996, the court refers to the shoulders on the prongs of the Wilson reamers and contrasts or compares these with the upwardly and inwardly tapered dove-tails on the open slipways of the Double reamers and says that they are not the same in principle or in operation. The attention of the court is particularly directed to its opinion in case No. 2996, in which it points out, on pages 6 to 10, that the provision of the pronged or open mouthed body and the straight shoulders give the Wilson reamer a distinct principle of action and mode of operation not comparable to the Double, and not the mechanical equivalent of the Double. Clearly, that which is old prior to the Wilson invention (i. e., the Double principle and mode of operation) cannot now be the mechanical equivalent of the Wilson. "Double Improved," Types

“D” and “E” reamers retain absolutely “opposite parallel bearing faces on the downward extension” referred to by the court in its opinion in case No. 2996, page 9, as not the equivalent of the inclined bearing faces on the prongs of the Wilson reamer. The court points out the mechanical differences in principle and mode of operation in the collapse and expansion and says that in none of these features are the two reamers equivalents. It is respectfully submitted that under these circumstances the Double reamer cannot infringe the Wilson patent.

In the opinion in this case Your Honors have considered this suit as though before Your Honors upon an appeal by the appellee from that portion of the decree of the District Court which dismissed suit “A-4” and the major part of suit “B-62,” and have considered only “Type F” reamer whereas this appeal is only before the court on appellant’s appeal from the award of the injunction and the substantial merits are the “Double Improved” and Types “D” and “E” reamers.

The confusion, which will result from such lack of decision, is emphasized by appellee’s motion to explain the opinion of the court, and by reference to the controversy now pending in this court in the Minerals Separation or flotation process case. The substantial reason for a clear and definite decision *of the issues by appellant’s appeal* is thus made apparent, to the end that further continued litigation between the parties be not rendered necessary to ascertain the rights of the

parties and the meaning of the court's opinion and to ascertain the scope given to the claims 9 and 19 under consideration on this appeal. To leave the case as it stands on the opinion filed is simply to compel further litigation.

For each of the foregoing reasons it is submitted a rehearing should be granted.

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